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TRANSMITTAL FORM

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Application Number	09/294,341
Filing Date	April 20, 1999
First Named Inventor	Masaaki HIROKI
Group Art Unit	2629
Examiner Name	R. Liang
Attorney Docket Number	0756-1964

ENCLOSURES *(check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☒ Amendment / Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
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- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Assignment Papers *(for an Application)*
- ☐ Drawing(s)
- ☐ Declaration and Power of Attorney
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
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- ☐ Status Letter
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Remarks

☒ The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 50-2280 for the above identified docket number.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Eric J. Robinson, Reg. No. 38,285 Robinson Intellectual Property Law Office, P.C. PMB 955 21010 Southbank Street Potomac Falls, VA 20165
Signature	
Date	September 26, 2006

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Attorney Docket No. 0756-1964

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Group Art Unit: 2629

Masaaki HIROKI) Examiner: Regina Liang

Serial No. 09/294,341)

Filed: April 20, 1999)

For: DISPLAY DEVICE)

CERTIFICATE OF MAILING

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Adam M Stamper

RESPONSE

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Official Action mailed June 26, 2006, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on May 21, 1999; April 14, 2004; March 23, 2006; May 12, 2006; and June 7, 2006.

Claims 1, 3-8, 10, 12-14, 16, 17, 19-21, 23, 25-33, 35 and 37-44 are pending in the present application, of which claims 1, 8, 14, 21, 27 and 33 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 3 of the Official Action rejects claims 1, 3-6, 8, 10, 12, 14, 16, 17, 19, 21, 23, 25, 27-31, 33, 35, 37 and 39-44 as obvious based on the combination of U.S. Patent No. 5,811,837 to Misawa, U.S. Patent No. 6,229,513 to Nakano and U.S. Patent

No. 4,645,947 to Prak. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Misawa, Nakano and Prak or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the features of the present invention.

The test for obviousness is not whether the references "could have been" combined or modified as asserted in the Official Action, but rather whether the references should have been. As noted in MPEP § 2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original). Thus, it is respectfully submitted that the standard set forth in the Official Action is improper to support a finding of *prima facie* obviousness.

The Official Action asserts that Figure 11 of Misawa discloses the following (pages 2-3, Paper No. 20060616):

> ... a pair of dual clocks signal for driving a shift register having a first clock signal CL (first signal) and a reversed clock signal CL (second signal) having a different phase from the first clock signal (first signal), and both the clock signal and the reversed clock signal (first signal and second signal) are transmitted to each of shift register unit cells. Misawa teaches noise [due] to the first and the second signals is reduced by the phase difference (col. 12, lines 31-34).

Also, the Official Action asserts that it would have been obvious "to modify the display device of Misawa to have the control circuit and the video signal processing circuit as taught by Nakano ..." and "in order to make and use Misawa's device with two different phase clock signals, it would have been obvious ... to modify the control circuit of Misawa as modified by Nakano to have a delay circuit as taught by Prak ..." (pages 3-4, Id.).

However, the Applicant does not agree that there is a suggestion or motivation, either in Misawa, Nakano and Prak or in the knowledge generally available to one of ordinary skill in the art, to combine Misawa and Prak in the manner asserted in the Official Action. Misawa clearly describes the following (column 12, lines 28-32):

> ... The rising edge of CL corresponds to the trailing edge of [CL with emphasis mark]. The rising edge of [CL with emphasis mark] corresponds to the trailing edge of CL. Consequently, clock noise added to the video signal is sharply reduced ... .

Misawa does not teach or suggest that noise due to first and second signals is reduced by a phase difference. On the other hand, Prak teaches a circuit including a clock divider circuit 11, a first delay means 12 and a second delay means 13 (Figure 1). The delay means 12 outputs a delay signal BPH1D, which "prevents the phase two clocking signal from overlapping the phase one clocking signal" (column 2, lines 32-53). Therefore, in Prak, a phase difference is used. As such, Misawa and Prak teach away from each other. Therefore, the Applicant respectfully submits that one of ordinary skill in the art at the time of the invention would not have had motivation to combine Misawa and Prak.

Further, it is not sufficient to merely point out the advantages of two references and assert that it would have been obvious to combine the two references so that you can have both advantages in one device. Rather, in order to form a *prima facie* case of obviousness, the Official Action must show why the references should have been combined.

Nakano does not cure the deficiencies to combine Misawa and Prak. Nakano is relied upon to allegedly teach a control circuit for generating a clock signal and a video signal processing circuit (page 3, Paper No. 20060616). However, Nakano does not teach why it would have been obvious to combine Misawa and Prak.

Therefore, the Applicant respectfully submits that the Official Action has not provided a proper or sufficient suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Misawa, Nakano and Prak or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Paragraph 4 of the Official Action rejects claims 7, 13, 20, 26, 32 and 38 as obvious based on the combination of Misawa, Nakano, Prak and U.S. Patent No. 5,801,678 to Shimada.

Please incorporate the arguments above with respect to the deficiencies in Misawa, Nakano and Prak. Shimada does not cure the deficiencies in Misawa, Nakano and Prak. The Official Action relies on Shimada to allegedly teach the features of the dependent claims. Specifically, the Official Action relies on Shimada to allegedly teach a projection type display device. However, Misawa, Nakano, Prak and Shimada, either alone or in combination, do not teach why it would have been obvious to combine Misawa and Prak. Since there is insufficient motivation to combine Misawa, Nakano, Prak and Shimada, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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